



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,869	12/30/2003	Steve Hurson	NOBELB.163A	3711
20995	7590	03/24/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			LEWIS, RALPH A	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3732	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,869	Applicant(s) HURSON, STEVE ed	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/30/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04062004, 08202004</u> | 6) <input type="checkbox"/> Other: ____ |

Objection to the Drawings

The drawings are objected to under 37 CFR 1.84 as being informal. The lines, numbers and letters lack uniformity and are fuzzy lacking sharp definition. Solid black shading is not permitted (Figures 2D, 4E, 5D, 7A, 7B, 9A and 9B). Figures 2A, 2C, 4A, 4D, 5B, 5C, 6B, 6C and 8A all have improper cross-sections for the disclosed plastic (see MPEP pg 600-99 for proper cross-sections). Element number 174 referred to at page 12 is missing from the drawings.

Corrected replacement drawings are required. No new matter should be entered. The objection to the drawings will not be held in abeyance.

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-17 and 30-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S.

Patent No. 6,769,913 in view of Hurson WO 01/85050. Although the conflicting claims

are not identical, they are not patentably distinct from each other because the patented claims of '913 teach the use of an impression cap with injection port and vent holes and use of a syringe to inject impression material into the cap through the injection port. Merely, providing for a '913 patented cap/method for use with the prior art Hurson implant so that impressions may be made more accurately would have been obvious to one of ordinary skill in the art.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-11 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hurson (WO 01/85050).

Hurson discloses in '050 a dental implant having a body portion 10 for securement in a patient's jawbone 110 and an abutment portion 38 which extends above the jawbone 110. The abutment includes a shoulder portion 47 that lies between a lower flared portion and an upper restoration portion. Hurson further discloses a healing cap 76 with a cavity for fitting over the restoration portion and a tissue retention flange 86 that extends below the shoulder 47 of the abutment portion. In regard to

claim 2, the abutment portion and the implant are capable of being permanently attached to one another if that is what one desired.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurson (WO 01/85050) in view of Kamiya et al (US 5,205,745).

Kamiya et al teach that it is known to combine the implant and the abutment of the implant into a single piece, thereby eliminating the need for costly interfitted pieces. To have constructed the Hurson implant and abutment as a single piece as taught by Kamiya in order to reduce the cost would have been obvious to one of ordinary skill in the art.

Claims 18-27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurson (WO 01/85050) in view of Marlin (US 5,135,395) and Meiers et al (US 5,688,123).

Hurson fails to disclose a procedure for manufacturing a prosthesis for the implant disclosed. Marlin teaches the conventional manufacture of a prosthesis with a plastic coping that precisely fits over the abutment, encasing it in stone and then

burning out the coupling leaving an opening in which the prosthesis is cast. To have provided a coping that precisely fits the Hurson abutment (e.g. one shaped like Meirs et al with "standoff" 5) and then using the coping to construct a prosthesis in a prior art investment cast technique as that disclosed by Marlin would have been obvious to one of ordinary skill in the art in desiring to construct a prosthesis for the Hurson implant.

Prior Art


Applicant's information disclosure statements of April 06, 2004 and August 20, 2004 have been considered and an initialed copies enclosed herewith. It is noted that a handful of the cited references are completely irrelevant to the claimed invention (e.g. U.S. patent 470,444) and a number of them are only marginally related to the claimed invention. Applicant's assistance in only citing prior art reasonably relevant to the claimed invention is requested.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3732

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
March 17, 2005



Ralph A. Lewis
Primary Examiner
Au3732